II. Applicants' Claim of Priority

As amended in Applicants' Transmittal Letter of 18 January 2001 and as further amended hereinabove, and as filed on 18 January, 2001, Applicants' specification, immediately below the title, reads as follows:

> Cross-Reference to Related Applications
>
> This is a divisional of U.S.S.N. 08/968,016 (now U.S. Patent No. 6,221,410), filed November 12, 1997, which is a continuation-in-part of copending U.S.S.N. 08/951,245 (now abandoned), filed in the U.S. Patent and Trademark Office September 25, 1992, in the name of R.K. Ramesh.

Applicants contend that the claim of priority amendment on the 18 January 2001 transmittal letter satisfies 37 CFR 1.78(a)(2) and (a)(5), and that the above amendments to this portion of Applicants' specification is directed to clerical and other minor matters of form, such as providing an updated status of the parent and grandparent applications as issued and abandoned, respectively. Accordingly, Applicants contend that the claim of priority has been established and maintained throughout the pendency of the instant application, and that no petition is needed to be accorded the benefit of the claim of priority, and that the above amendments to the specification include no new matter. An appendix indicating the various amendments to the specification is provided herewith.

III. The Rejections under 35 U.S.C. §112, Second Paragraph

In Paragraph 3 of the 20 November 2002 office action, Claims 29-48 are rejected as indefinite for the recitation of the following phrases: "first polyamide", "second polyolefin", "second polyamide", "thickness of at least about 5% of a total film thickness", "of at least 90 degrees", "at least 9 percent", and "of from about 5 to 20 percent".

In response, Applicants contend that Claims 29-48 are not indefinite for the recitation of any one or more of the above phrases. The rejection in Paragraph 3 merely identifies the phrases and cites the location of the phrases in one of the claims, but does not state why any one or more of the subject phrases are indefinite, i.e., what makes the phrases indefinite. Applicants contend that none of the subject phrases are indefinite, because the scope of the claim (including the phrase) is ascertainable. Applicants also contend that unless and until the PTO states why the identified phrases are indefinite, there is no basis for a 35 USC 112 second paragraph rejection of any one or more of Applicants' claims. In other words, Applicants contend that the language of Paragraph 3 of the Office Action is conclusory, and provides no reason for the characterization of Applicants recitations as "indefinite".

In addition, Applicants note that parent application U.S.S.N. 08/968,016 issued as U.S.P.N. 6,221,410, reciting all of the phrases which are the subject matter of the instant rejection. Thus, Paragraph 3 of the Office Action is inconsistent with this issuance of the claims in the '410 patent, i.e., Paragraph 3 fails to give full faith and credit to the clarity of the claims in

U.S.P.N. 6,221,410, which contain all of the phrases which are identified as lacking clarity in Paragraph 3.

Based on all of the above, Applicants respectfully request that the rejection under 35 USC 112, second paragraph, be either explained or withdrawn. Of course, the undersigned is more than willing to consider and respond to any specific reasons advanced for the indefiniteness of any one or more of the identified phrases recited in Applicants' Claims 29-48.

IV. The Rejections under 35 USC 103(a)

In Paragraph 5 of the 20 November 2002 office action, Claims 29-48 are rejected as unpatentable over U.S. Patent No. 3,130,647, to Anderson et al ("ANDERSON et al") in view of U.S. Patent No. 4,448,792, to Schirmer ("SCHIRMER"). The Office Action states that ANDERSON et al discloses a process for making a backseamed casing by making a multilayer shrink film, wrapping the film around a forming shoe and backseaming while forwarding, and that ANDERSON et al discloses varying the thickness of at least one ply of the film. The Office Action then concludes that as a matter of design choice, it would have been obvious to one of ordinary skill in the art to select a plastic such as anhydride-containing polyolefin with at least 1 weight percent anhydride. The Office Action goes on to admit that ANDERSON et al does not disclose a film having three to six layers, but that SCHIRMER discloses a six layer shrink film having an oxygen barrier layer, for use in a shrink bag, and that SCHIRMER discloses using propylene homo- or co-polymers for use in a specific layer, as well as the presence of a crosslinked polymer network in at least one layer and a sealed article having a lap seal. The

Examiner then took official notice that limitations such as Vicat softening point of 90 degrees, 9 weight percent unsaturated acid mer, layer variations, etc, are obvious design choices, and that at the time the invention was made, one of ordinary skill in the art would provide the desired polymer because Applicant has not disclosed that doing so provides an advantage, is used for a specific purpose, solves a problem, etc., and that one of ordinary skill in the art would have expected Applicants' invention to perform equally well with the disclosed teachings of ANDERSON et al and SCHIRMER because all of the method steps of forming the backseam have been anticipated. As to the thickness ranges and weight percentages, the Office Action states that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

In response to the §103 rejection, Applicants contend that Claims 29-48 are patentable over ANDERSON et al in view of SCHIRMER. Before turning to a discussion of the specifics of ANDERSON et al and SCHIRMER, Applicants note that each of the pending independent claims is directed to a process in which a multilayer film is backseamed on a forming shoe and then forwarded from the forming shoe. The multilayer film has a second layer having a thickness which is at least 5% of the total thickness of the multilayer film. The second layer comprises polyamide and/or polyester. Applicants have discovered that the presence of an inner (i.e., internal) layer comprising polyamide and/or polyester and having a thickness of at least 5% of the total film thickness solves a problem. The problem is that the film necks down on the forming shoe during backseaming. Necking down means tightening on the forming shoe so that

the film cannot be forwarded off of the forming shoe. The film Applicants' recite in each of their independent process claims exhibits little or no necking down on the forming shoe. Thus, contrary to the statement in the Office Action that Applicants have not disclosed that their film design provides an advantage, it is clear that indeed Applicants' film design DOES provide an advantage, in that it solves the necking down problem on the forming shoe. Compare the backseaming results for Applicants' Examples 1-6 with the comparative results provided for Applicants' Comparative Examples 7 and 9, as set forth on Pages 43-56, as well as the summary on Page 62 line 14 through Page 73 line 26 of Applicants' specification. Applicants contend that even if a prima facie case of obviousness has been made out, the results set forth in Applicants' specification rebut the prima facie case with evidence of unexpected results and problem solved.

Turning to the inadequacy of the prima facie case, Applicants note that ANDERSON et al discloses backseamed bags made from webs which are loosely bonded to one another, with, for example, one of the webs being polyethylene or polystyrene or polyamide or polyvinylidene chloride (or other polymer), and the other web being provided with an outer layer of paper or foil or cellophane. The Office Action does not point out where ANDERSON et al teaches or suggests a multilayer structure having an internal polyamide layer which makes up at least 5% of the overall film thickness, as recited in each of Applicants' independent Claims 29 and 48. Moreover, a review of ANDERSON et al by the undersigned does not reveal any teaching or suggestion in ANDERSON et al of a multilayer film having such an internal layer. Applicants contend that with no teaching or suggestion of such an internal layer, and with no motivation to

modify the structure of ANDERSON et al to arrive at a multilayer film having such an internal layer, ANDERSON et al does not establish a prima facie case of obviousness of either of Applicants' independent Claims 29 and 48.

Applicants further contend that while the rejection is based on ANDERSON et al in view of SCHIRMER, the Office Action relies upon SCHIRMER for the disclosure of multilayer films having six layers, including an oxygen barrier layer comprising polyvinylidene chloride, in the form of a casing film which shrinks at 185°F, and that SCHIRMER discloses using propylene homo- or co-polymers for a specific layer, as well as the presence of a crosslinked polymer network. However, Applicants point out that the Office Action does not state that SCHIRMER teaches or suggests an internal layer comprising nylon or polyester, with the internal layer making up at least 5% of the total film thickness. Thus, neither ANDERSON et al nor SCHIRMER are relied upon as teaching or suggesting this feature, which is recited in both of Applicants' independent claims. As a result, coupled with Applicants' evidence that this feature is critical to the operability of their claimed process, it is clear that Claims 29 and 48 are patentable over ANDERSON et al in view of SCHIRMER, as no prima facie case of obviousness has been set forth in the Office Action, and Applicants' solution to the necking down problem would overcome any prima facie case if it were there, which it is not.

The Office Action appears to take the position that variations of layer thickness and layer composition are "obvious matters of design choice". Applicants disagree. There must be some

teaching or suggestion or some basis for a motivation to arrive at Applicants' claimed process from the disclosures of ANDERSON et al and SCHIRMER. ANDERSON et al fails to recognize any necking down problem in the making of a backseamed casing on a forming shoe. Although SCHIRMER teaches multilayer films for cook-in end use, SCHIRMER does not teach or suggest a multilayer film having an internal layer comprising nylon or polyester, as recited in Applicants' independent Claims 29 and 48. The combination of ANDERSON in view of SCHIRMER fails to arrive at a multilayer film having an internal layer comprising polyamide and/or polyester with the layer having a thickness of at least 5% of the total film thickness. For at least this reason, Applicants' claims are all patentable over ANDERSON et al in view of SCHIRMER. In making the arguments for the patentability of the pending independent claims, Applicants do not waive any additional arguments to these or any other pending claims in this application.

Reconsideration of the patentability of the pending claims is respectfully requested, with a view towards allowance, in view of the points raised above.

Respectfully submitted,

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APPENDIX

The various amendments to Page 1 lines 1- 16 of the specification are provided below, with the language in brackets to be deleted, and the language which is underlined and not within brackets being added language.

BACKSEAMDED CASING AND PACKAGED PRODUCT INCORPORATING SAME

Cross-Reference to Related Applications

This is a divisional of [application no.] U.S.S.N. 08/968,016 (now U.S. Patent No. 6,221,410), filed [on] November 12, 1997, which

[Cross-Reference to Related Application]

[This application] is a continuation-in-part of copending U.S.S.N. 08/951,245 (now abandoned), filed in the U.S. Patent and Trademark Office [on] September 25, 1992, in the name of R.K. Ramesh.